

27 MAY 2004

#7



UNITED STATES PATENT AND TRADEMARK OFFICE

COMMISSIONER FOR PATENTS
UNITED STATES PATENT AND TRADEMARK OFFICE
P.O. Box 1450
ALEXANDRIA, VA 22313-1450
www.uspto.gov

Kent A. Herink
DAVIS BROWN KOEHN SHORS & ROBERTS
666 Walnut Street
The Financial Center Suite 2500
Des Moines, Iowa 50309-3993

In re Application of	:	
NELSON	:	
U.S. Application No. 09/424,052	:	
PCT No.: PCT/GB98/01549	:	DECISION ON PETITION
Int. Filing Date: 27 May 1998	:	UNDER 37 CFR 1.181
Priority Date: 30 May 1997	:	
Attorney Docket No. 4532670/2062	:	
For: METHOD OF CO-CRYSTALLIZING A	:	
FOOD ADDITIVE:	:	

This decision is in response to applicant's "Petition to Withdraw of Holding of Abandonment," which is being treated as a petition under 37 CFR 1.8(b) filed in the Patent and Trademark Office (PTO) on 20 January 2004. No petition fee is required.

BACKGROUND

On 27 May 1998, applicant filed international application PCT/GB98/01549 which claimed a priority date of 30 May 1997 and which designated the United States. A copy of the international application was communicated to the United States Patent and Trademark Office from the International Bureau on 03 December 1998. A Demand was filed with the International Preliminary Examining Authority prior to the 19th month from the earliest claimed priority date. As a result, the deadline for payment of the basic national fee was to expire 30 months from the priority date, or at midnight on 30 November 1999.

On 17 November 1999, applicant filed a transmittal letter requesting entry into the national stage in the United States, which was accompanied by, inter alia: the basic national fee; a copy of the international application; and amendments to the claims of the international application under PCT Article 19.

On 07 January 2000, the United States Designated/Elected Office (DO/EO/US) mailed a NOTIFICATION OF MISSING REQUIREMENTS UNDER 35 U.S.C. 371 (Form PCT/DO/EO/905) indicating that an executed oath or declaration in compliance with 37 CFR 1.497 was omitted. A new oath or declaration in compliance with 37 CFR 1.497 and a surcharge for providing the oath or declaration later than 30 months from the priority date were required. The notification set a one (1) month period for response.

On 16 May 2000, applicant filed a petition under 37 CFR 1.137(a); a declaration and power of attorney; and the surcharge for supplying an oath or declaration later than 30 months from the priority date. In a decision dated 09 August 2000, applicant's petition under 37 CFR 1.137(a) was dismissed as moot, however, the Office of PCT Legal Administration required further evidence that the declaraton was properly executed by the first inventor.

On 21 November 2002, the United States Designated/Elected Office (DO/EO/US) mailed a NOTIFICATION OF ABANDONMENT indicating that the application was abandoned for failure to respond to the Notification of Missing Requirements mailed 07 January 2000. (The notification of abandonment should have indicated that the application was abandoned for failure to respond to the "Decision on Petition" mailed 09 August 2000.)

On 20 January 2004, applicant filed the present petition. The petition was accompanied by: a copy of a transmittal letter dated 31 August 2000; a copy of "Confirmation of Authenticity of Declaration filed under 37 CFR 1.497" dated 31 August 2000; and a copy of the combined declaration and power of attorney filed 16 May 2000.

DISCUSSION

The above-identified application was abandoned on 11 September 2000 for failure to respond to the "Decision on Petition" mailed 09 August 2000. Applicant states in the present petition that the "Confirmation of Authenticity of Declaration filed under 37 CFR 1.497" was mailed to the United States Patent and Trademark Office on 31 August 2000 under 37 CFR 1.8. A review of the application file reveals that the "Confirmation of Authenticity of Declaration filed under 37 CFR 1.497 allegedly filed 31 August 2000 under 37 CFR 1.8 is not located therein.

37 CFR 1.8 states:

In the event that correspondence is considered timely filed by being mailed or transmitted in accordance with paragraph (a) of this section, but not received in the Patent and Trademark Office, and the application is held to be abandoned or the proceeding is dismissed, terminated, or decided with prejudice, the correspondence will be considered timely if the party who forwarded such correspondence:

- (1) Informs the Office of the previous mailing or transmission of the correspondence promptly after becoming aware that the Office has no evidence of receipt of the correspondence;
- (2) Supplies an additional copy of the previously mailed or transmitted correspondence and certificate; and
- (3) Includes a statement which attests on a personal knowledge basis or to the satisfaction of the Commissioner to the previous timely mailing or transmission.

The evidence filed with the petition is convincing that a response including the "Confirmation of Authenticity of Declaration filed under 37 CFR 1.497" was filed with a certificate of mailing dated 31 August 2000. The response filed 31 August 2000 was timely to the "Decision on Petition" mailed 09 August 2000. Additionally, applicant has: (1) informed the Office of the previous mailing of the correspondence promptly after becoming aware that the Office did not receive the items mailed 31 August 2000, (2) supplied copies of the previously mailed correspondence; and (3) Kent Herick states that "Confirmation of Authenticity of Declaration filed under 37 CFR 1.497" was submitted on August 31, 2000. Thus, it is considered appropriate to withdraw the holding of abandonment.

A review of the declaration and "Confirmation of Authenticity of Declaration filed under 37 CFR 1.497" reveals that the declaration filed 16 May 2000 is in compliance with 37 CFR 1.497(a)-(b).

CONCLUSION

As construed above, applicant's petition under 37 CFR 1.181 to withdraw the holding of abandonment is GRANTED.

The Notification of Abandonment mailed on 21 November 2002 is hereby VACATED.

The application has an international filing date of 27 May 1998 under 35 U.S.C. 363, and a 35 U.S.C. 371(c)(1), (c)(2), and (c)(4) date of 16 May 2000.

This application is being forwarded to the National Stage Processing Branch of the International Division for further processing.



Anthony Smith
Attorney-Advisor
Office of PCT Legal Administration
Telephone 703-308-6314
Fax: 703-308-6459